



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,814	02/27/2004	John G. Babish	068911-0075	5630

7590 02/07/2008
Simona A. Levi_Minzi PH.D.,JD
Mcdermott Will Emery LLP
201 S. Biscayne Boulevard, ste.2200
Miami, FL 33131

EXAMINER

KANTAMNENI, SHOBHA

ART UNIT	PAPER NUMBER
----------	--------------

1617

MAIL DATE	DELIVERY MODE
-----------	---------------

02/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,814

Applicant(s)

BABISH ET AL.

Examiner

Shobha Kantamneni

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/26/2007</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/26/2007 has been entered.

Applicant's amendment filed on 09/26/2007, wherein claims 4, and 7 have been amended. Applicant's amendment also cancelled claims 1-3.

The rejection of Claims 4-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending Application No. 10/464410; the rejection of claims 4-7 as being unpatentable over claims 1-34 of copending Application No. 10/464834; the rejection of instant claims as being unpatentable over claims 1-12 of copending Application No. 10/689856; unpatentable over claims 1-6 of copending Application No. 10/774048 made in the office action dated 05/04/2005 is MAINTAINED.

The rejection of Claims 4-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-115 of copending Applications 11/344555, 11/344556, 11/344557; the rejection of claims 4-7 as being unpatentable over claims 1-34 of copending Applications 11/344552, 11/344554, 11/403034; the

rejection of instant claims as being unpatentable over claims 1-12 of copending Application No. 10/789817 made in the office action dated 10/19/2006 is MAINTAINED.

Applicant's amendment by cancelling claims 1-3 overcomes the rejection of claims 1-3 under 35 U.S.C 102(e) as being anticipated by Shahlal et al. (US 6,583,322, PTO-892).

Applicant's arguments have been considered, and found persuasive. The rejection of claims 4-7 under 35 U.S.C. 103(a) as being unpatentable over Tobe (US 5,604,263, PTO-892) is herein withdrawn.

Claims 4-7 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention fails to find written description for possession of the claimed reduced isoalpha acid (RIAA) isolated from hops. The specification on page 10, paragraph [035], discloses that the term "reduced isoalpha acid" refers to alpha acids isolated from hops plant product and which subsequently have been isomerized and

reduced, including cis and trans forms. Thus, the specification does not provide support for " reduced isoalpha acid isolated from hops" since according to the specification reduced alpha acids are not naturally occurring from hops, and have to go through a series of steps such as isomerization and reduction to obtain from hops. Thus, the claims need to be limited to the claimed reduced isoalpha acids as derived from hops, since that is all is on record as having possessed by the applicant at the time the invention was made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 contains the abbreviations or trademark/trade RIAA, and IAA in the claim. Where a trademark or trade or abbreviation name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirement of 35 U.S.C. 112, second paragraph. See *Exparte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the abbreviation or trademark or trade name cannot be used properly to identify any particular material or product. A abbreviation or trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a abbreviation or trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the abbreviation trademark/trade name

Application/Control Number:
10/789,814
Art Unit: 1617

Page 5

or abbreviation is used to identify/describe particular agent, accordingly, the identification/description is indefinite.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Tuesday-Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
Art Unit : 1617



SREENI PADMANABHAN
SUPERVISOR, PATENT EXAMINER